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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD

Proceeding	92048667
Party	Defendant Peter Baumberger
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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD

Jules Jurgensen/Rhapsody, Inc.,	)	
	)	Cancellation No: 92048667
Petitioner,	)	
	)	Registration No.: 3,181,224
v.	)	
	)	
Peter Baumberger,	)	
	)	
Respondent.	)	
	)	

REPLY IN SUPPORT OF MOTION FOR JUDGMENT AND
OPPOSITION TO PETITIONER'S REQUEST FOR RECONSIDERATION

I. INTRODUCTION

Petitioner, Jules Jurgensen/Rhapsody, Inc., does not dispute that judgment must be entered in favor of Respondent if the Board's precedential decision striking the testimony deposition of Morton Clayman is allowed to stand. Respondent's entire brief is therefore devoted to the improper rehashing of arguments it raised in opposition to Respondent's motion to strike and to the similarly improper attempts to introduce new evidence in support of its position.

The Board's decision striking the testimony deposition of Mr. Clayman was grounded solidly upon the Board's disclosure rules, and the decision sent a clear message to practitioners that the rules must be followed. Petitioner has forwarded no satisfactory explanation for its failure to follow the rules, and therefore, to preserve the integrity of those rules, the Board should grant Respondent's Motion for Judgment and deny the Request for Reconsideration.

A. The Board Should Reject Petitioner's Attempt to Rehash Old Arguments.

A motion for reconsideration should be granted only where, based on the facts before it and the applicable law, the Board erred in reaching the order it issued. A motion for reconsideration should not be devoted simply to a re-argument of the points presented in a brief on the original motion. T.B.M.P. § 543.

Here, the Board has already considered and rejected Petitioner's arguments that Respondent "was aware" of the identity of Mr. Clayman and the relevance of his testimony. See Order of July 6, 2009 at 6-7 ("Order"). The Board has properly noted that the pretrial disclosure rule is an independent requirement that "cannot be ignored simply because some information about a testifying individual may be known by the adverse party or parties." Order at 7.

Similarly, the Board has properly considered and rejected Respondent's argument that it was somehow Respondent's actions, rather than Petitioner's failure to follow the rules, that caused prejudice to Respondent. (See Order at 6, noting that "this argument is not well taken".)

As with its efforts to rehash rejected arguments, Petitioner's attempts to introduce new evidence in the form of a description of its attorney's time records should be rejected. (Request for Reconsideration at 6.) This evidence was not before the Board on the Motion to Strike. Therefore it should not be considered. T.B.M.P.§ 543; *Amoco Oil Co. v. Americo, Inc*., 201 U.S.P.Q. 126 (TTAB 1978). Nor is it properly before the Board in this instance, since it is not supported by a declaration or other statement under oath. T.B.M.P. § 704.06(b); *Electronic Data Systems Corp. v. EDSA Micro Corp.*, 23 USPQ2d 1460, 1462 n.5 (TTAB 1992) (additional revenue figures

provided in trial brief not considered); *Abbott Laboratories v. Tac Industries, Inc.*, 217 USPQ 819, 823 (TTAB 1981) (factual statements regarding certain scientific matter which cannot be deemed to be public knowledge not considered). Therefore, the Board should disregard Petitioner's attempt to introduce new evidence, particularly new evidence that is presented only in the form of attorney argument.

B. The Plain Language of the Rules Provides Alternate Remedies for a Party's Non-Compliance with Pre-Trial Disclosure Rules.

Petitioner forwards the curious argument the Board's rule 2.123(e)(3) which provides that a party "may" seek to strike the testimony of an undisclosed witness is preempted by the Board Rule 2.121(e), which provides that a party "may" move to delay or reset pretrial disclosure and trial deadlines where the adverse party fails to make the required pretrial disclosures. Clearly, by their plain language, these rules provide alternate remedies, which the Board may consider "on the basis of all relevant circumstances." 37 C.F.R. § 2.123(e)(3). Here, the Board has considered the relevant circumstances and has determined that Petitioner offered no adequate justification or reason for its failure to make proper disclosures under the rules.

Petitioner claims that it gave adequate notice of its intent to take trial testimony because it made no statement in pretrial disclosures that it intended to forgo witness testimony and rely solely on documents. See 37 C.F.R. § 2.121(e). Petitioner asserts that Respondent should have gleaned from the absence of such a statement that Petitioner intended to rely on witness testimony. However, as the Board has already pointed out, Petitioner failed to submit *any* Pretrial Disclosures. (Order at 5 n.4.) Surely, the absence of a statement regarding witness testimony from pretrial disclosures that Petitioner never made cannot constitute notice that a Petitioner intended to

introduce testimony. Moreover, even if it could constitute such notice, Petitioner still failed to disclose the witness's identity and a summary of the witness's testimony as required under Rule 2.123(e)(3).

C. Petitioner Has Offered No Explanation or Justification for its Failure to Follow the Rules.

Petitioner's brief is devoted to criticizing Respondent for its actions or inaction and the Board for its decision to strike Mr. Clayman's testimony. Noticeably absent from the brief is any attempt to provide any explanation or justification as to why Petitioner did not identify Mr. Clayman, who it describes as a "critical" witness, either in initial disclosures or pretrial disclosures – a point on which it bears the burden. (See Opp. to Motion to Strike at 1.); *Finley v. Marathon Oil Co.*, 75 F.3d 1225, 1230 (7th Cir. 1996); *Cooley v. Great Southern Wood Preserving*, 138 Fed. Appx. 149, 161 (11th Cir. 2005); *Burney v. Rheem Mfg'g Co., Inc.*, 196 F.R.D. 659, 691 n. 29 (M.D. Ala. 2000). Absent a reasonable justification for failure to disclose the testimony of a "critical" witness, the Board should not reverse its well-considered and precedential decision striking Mr. Clayman's testimony in its entirety.

D. Failure to Disclose Mr. Clayman in Initial Disclosures Provides Alternate Support for the Board's Decision to Strike Mr. Clayman's Testimony.

Petitioner's Brief has also ignored its failure to disclose Mr. Clayman's identity as a knowledgeable individual in its initial disclosures or in any supplements. This breach of the disclosure rules provides an alternate, independent basis for the Board's Order striking Mr. Clayman's testimony. A party who fails to identify a witness in its initial disclosures may not call that witness to testify at trial unless the failure was substantially justified or is harmless. Fed. R. Civ. P. 37(c)(1). The sanction of exclusion is automatic and mandatory unless the offending party can show that its

violation was either justified or harmless. *Zhang v. American Gem Seafoods, Inc.*, 339 F.3d 1020 (9th Cir. 2003); *Tronknya v. Cleveland Chiropractic Clinic*, 280 F.3d 1200 (8th Cir. 2002) (holding that there was no substantial justification for the failure to disclose witnesses, the failure to disclose was not harmless, and the district court did not abuse its discretion in excluding all testimony of witnesses which were not included in the party's disclosures or supplements); *Sears, Roebuck & Co. v. Goldstone & Sudalter*, 128 F.3d 10, 18 n.7 (1st Cir. 1997) (striking the affidavit of a witness whose identity was not disclosed at the outset of litigation was well within the district court's discretion). As with its failure to follow the pretrial disclosure rules, Petitioner has offered no reasonable justification for its failure to follow the initial disclosure rules. And Petitioner's failure to identify this "critical" witness in initial disclosures, constitutes an independent ground upon which to exclude his testimony.

II. CONCLUSION

As a result of Respondent's own failure to disclose the identity of a critical witness either in initial disclosures or pretrial disclosures as required by the Board's rules, the Board, based on all relevant circumstances, properly struck the testimony of Mr. Clayman. It should not revisit this well-considered and precedential decision.

The record as it currently stands contains no evidence in support of Respondent's Petition to Cancel. Therefore, the Board should enter judgment in favor of Respondent and dismiss the Petition.

Dated: September 8, 2009

Respectfully submitted,

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CERTIFICATE OF SERVICE

I certify that on September 8, 2009, a copy of the above **Reply in Support of Motion for Judgment and Opposition to Petitioner's Request for Reconsideration** was served to the following by:

- ☒ U.S. Mail, postage prepaid
- ☒ Email
- ☐ Hand Delivery
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